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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,520	06/27/2001	James P. Kardach	42390P11689	5997

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/894,520	<b>Applicant(s)</b> KARDACH, JAMES P.	
	<b>Examiner</b> Kimberly D. Nguyen	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Acknowledgement is made of Amendment filed 12 January 2004.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 10-16 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnus et al. (WO 02/082359; hereinafter "Magnus") as modified by Zdybel, Jr. et al. (US 5,486,686; hereinafter "Zdybel, Jr.").

Re claims 1-2, 4-6, 10-14, 16 and 20-25: Magnus teaches a method comprising:

printing a hardcopy representation/coupon 9 of an electronic application on a paper having printed pattern thereon (page 3, line 29 through page 4, line 10);

recording one or more edits made with a pen 1 on the hard copy representation 14 by recording movements of the pen 1 with respect to the printed pattern (fig. 1; page 7, lines 16-34; page 9, line 16 through page 10, line 21);

automatically sending the one or more edits made on the hard copy representation 14, via wireless transmission, to a computer system at one or more predetermined time without user intervention (wherein one/a predetermined time without user intervention is time when a desired amount of written information has been stored upon transmitting the information to the

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computer; see page 7, lines 28-34) (figs. 2-3; page 7, line 15 through page 8, line 17; page 9, lines 16-35).

Although, Magnus teaches a unique printed pattern paper can be used for identifying a particular publisher (page 4, lines 4-6); Magnus fails or fairly suggests that the hard copy representation having identification information to associate the hard copy representation with the electronic application.

Zdybel, Jr. teaches a method of a hard copy representation having identification information, such as file name, to associate the hard copy representation with the electronic application (col. 10, lines 1-27).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known identification information associating the hard copy and the electronic application as taught by Zdybel, Jr. to the teachings of Magnus in order to keep track of the hard copy with the electronic application.

Re claims 3, 15: Magnus teaches a method, wherein recording the information, such as winners, match results, number etc, comprises making a mark with the pen in the area/box with specific information (page 5, lines 1-3; page 8, lines 12-17).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to manipulate the information such as the identification information, as necessary, to fit his/her business criteria to further inform the computer system of file(s) being edited or changed. Furthermore, such modifications would provide an inventory tracking of files/application being changed, edited or updated.

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4. Claims 7-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnus as modified by Zdybel, Jr. as applied to claim 1 above, and further in view of Patton et al. (US 5,757,468; hereinafter "Patton"). The teachings of Magnus as modified by Zdybel, Jr. have been discussed above.

Magnus as modified by Zdybel, Jr. is silent with respect to the identification information comprises an ID printed with an icon on the hard copy representation.

Patton teaches a print paper/hard copy wherein the identification information comprises a unique identification number "000001" and a bar code 320, which serves as an ID, with an icon 12 on the print paper (fig. 11; col. 7, lines 55-67).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to manipulate the informative data with an icon as taught by Patton to the teachings of Magnus as modified by Zdybel, Jr. in order to provide a visual acknowledgment of the information (i.e. ID) printed with an icon to the operator to further offer an aesthetic appeal to the hard copy.

#### ***Response to Arguments***

5. Applicant's arguments filed 12 January 2004 have been fully considered but they are not persuasive.

6. In response to applicant's argument that "Claim 1 as amended sets forth **"automatically** sending the one or more edits made on the hard copy representation, via wireless transmission, to a computer system **at one or more predetermined time without user intervention**" (claim 1, emphasis added). In contrast, Magnus does not disclose automatically sending edits to a computer system at one or more predetermined time without user intervention." (see page 2,

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lines 8-12); the examiner respectfully submits that according to Magnus “When the desired amount of written information has been stored in the memory, this can be transmitted at an optional time and be sent on wirelessly via a transmitter 7 which in a preferred embodiment is a so-called Bluetooth transmitter.” (see Magnus, page 7, lines 28-32), that is, the information/data transmitting process can be set up at an optional time, and the information/data is **automatically sent without user intervention** at a predetermined/set-up time. Accordingly, Magnus and Zdybel, Jr. meet the claimed invention.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

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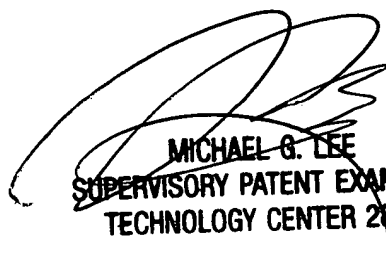
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

17 April 2004



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